

REMARKS/ARGUMENTS

Claims 1-25 are pending in this Application.

Claims 1, 8, 13, 15, and 19-21 are currently amended. Applicants respectfully submit that support for the claim amendments can be found throughout the specification and the drawings.

Claims 1-25 remain pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 15-25 stand rejected under 35 U.S.C. § 101 as allegedly being directed to nonstatutory subject matter. Claims 1-3, 7, 8, 11, 12, 15-17, and 21-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0229670 (hereinafter “Beyda”) in view of U.S. Patent No. 6,704,772 (hereinafter “Ahmed”), although they are listed to be rejected in view of U.S. Patent Application Publication No. 2003/0236763 (hereinafter “Kilduff”). Claims 4 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beyda, in view of Kilduff and in further view of Official Notice. Claims 5, 6, 13, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable of Beyda, in view of Kilduff, in further view of U.S. Patent Application Publication No. 2001/0056508 (hereinafter “Arneson”). Claims 9, 10, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beyda, in view of Kilduff, in further view of U.S. Patent No. 7,318,098 (hereinafter “Steinberg”).

Claim Rejections Under 35 U.S. C. § 103(a)

Applicants respectfully traverse the rejections to claims 1-25 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Beyda, Ahmed, Kilduff, Arneson, and Steinberg. The Office Action alleges that claimed invention is directed to obvious subject matter, in that the combination of Beyda, Ahmed, Kilduff, Arneson, and Steinberg expressly or impliedly disclose or suggest the claimed invention. The Office Action further alleges that one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of Beyda, Ahmed, Kilduff, Arneson, and Steinberg.

Applicants, however, respectfully submit that a prima facie case of obviousness has not been established by the evidence presented in the Office Action. As reiterated by the Supreme Court in KSR International Co. v. Teleflex Inc. (KSR), 550 U.S. ___, 82 USPQ2d 1385 (2007), the framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries enunciated by the Court are as follows:

(A) Determining the scope and content of the prior art;

(B) Ascertaining the differences between the claimed invention and the prior art;

and

(C) Resolving the level of ordinary skill in the pertinent art.

To reach a proper determination under 35 U.S.C. § 103(a), the Examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. (M.P.E.P. § 2142).

Applicants respectfully submit that Beyda, Ahmed, Kilduff, Arneson, and Steinberg, either individually or in combination, fail to disclose one or more of the claim limitations recited in each of claims 1-25. These differences, along with other difference, establish that the subject matter as a whole of claims 1-25 would not have been obvious at the time of invention to a person of ordinary skill in the art.

For example, even if Beyda and Ahmed were combined as alleged, the combination still fails to disclose the mechanism used to determine which action to perform as recited in amended claim 1. The method of amended claim 1 recites, in part, retrieving stored state information that is unique to a message sent to a device using a computer system that acts as an intermediary for devices that need to access as set of applications to obtain a mapping associating at least a portion of action information with a message identifier based on the message identifier as received in a response message from the device. On page 4, the Office Action recognizes that a mapping associating at least a portion of action information with a message identifier as recited in amended claim 1 is missing from Beyda because the Office

Action acknowledges that Beyda fails to disclose that messages send to a device include message identifiers “used to retrieve the stored information associating the actions and the message.”

The Office Action merely concludes that “some sort of identification is almost certainly included” without readily determining the scope and content of the prior art as required under Graham. The Office Action concludes “[s]ome mechanism must be used to determine which actions are associated with the ‘1’ or ‘2’.” Yet, the instant messaging system of Beyda does not disclose any sort of identification mechanism for messages or actions. Furthermore, one of ordinary skill could readily understand middleware 154 to operate without such as mechanism. For example, the end of paragraph [0077] in Beyda suggests that middleware 154 may provide or initiate an appropriate or corresponding response to application 152 thereby reasonably suggesting that middleware 154 merely forwards any response received from the user to the application. Thus, the simple act of forwarding by middleware 154 would negate an almost certain requirement as alleged in the Office Action.

The Office Action then attempts to rely on the alleged teachings of Ahmed where a message identifier is used to identify a reply to an original message. However, merely combining the message identifier as alleged in Ahmed with Beyda to identify the original message from a reply still does not disclose message identifiers “used to retrieve the stored information associating the actions and the message” as acknowledged to be missing from Beyda. Yet, the Office Action concludes that middleware 154 of Beyda would be able to determine which actions to perform if the alleged combination of Beyda and Ahmed would allegedly allow middleware 154 to determine which alert message is associated the choice in a given response message. The conclusion falls short though because the Office Action has yet to explain the particular mechanism in either Bedyda or Ahmed that could be used by middleware 154, once determining the original message that is associated with a choice, to retrieve stored information associating actions and messages to determine which actions to perform. The method of amended claim 1 recites one example of such a mechanism.

The method of amended claim 1 recites, in part, retrieving stored state information that is unique to a message sent to a device using a computer system that acts as an intermediary for devices that need to access as set of applications to obtain a mapping

associating at least a portion of action information with a message identifier based on the message identifier as received in a response message from the device. As recited in amended claim 1, stored action information corresponding to an action in one or more actions is retrieved using the computer system from the portion of the stored action information associated with the message identifier using at least one of one or more action identifiers for actions represented in the message sent to the device. Applicants respectfully submit that the alleged combination of Bedya and Ahmed fail to provide the mechanism as recited in amended claim 1 using the mapping and the action identifies.

Applicants respectfully submit that independent claims 8, 15, and 21 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others. Applicants respectfully submit that dependent claims 2-7, 9-14, 16-20, and 22-25 that depend directly and/or indirectly from the independent claims 1, 8, 15, and 21 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further respectfully submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

Unless otherwise specified, amendments to the claims are made for the purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof.

While Applicants do not necessarily agree with the prior art rejections set forth in the Office Action, these amendments may be made to expedite issuance of the Application. Applicants reserve the right to pursue claims to subject matter similar to those pending before the present Amendment in co-pending or subsequent applications.

Claim Rejections Under 35 U.S.C. § 101

Applicants respectfully traverse the rejections to claims 15-25 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 101. However, at the request of the Office Action, Applicants have amended the rejected claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

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